

Remarks

Claims 1-16 were previously pending in the subject application. By this amendment, the applicants have amended claims 1 and 10 and have cancelled claims 8 and 11. Support for the amendments can be found in previous claims 8 and 11 and throughout the specification. No new matter has been added by these amendments. Accordingly, claims 1-7, 9-10, and 12-16 are before the Examiner for consideration. Favorable consideration of the claims now presented, in view of the remarks and amendment set forth herein, is respectfully requested.

It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of the applicants' agreement with, or acquiescence in, the outstanding rejections.

Claims 10-16 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as the invention. The applicants thank the Examiner for his careful reading of the claims. Claim 10 has been amended to provide antecedent support for the recitation of "the medium." Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph is respectfully requested.

Claims 1-6 and 8-16 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of co-pending Application No. 10/545,275 (the '275 application). The applicants respectfully traverse this ground of rejection because the claims of the present invention are patentably distinct over the claims of the cited co-pending application.

The claimed invention is drawn to a method and device for the detection of an analyte in a fluid, where the fluid is contacted with a holographic element. An optical characteristic of the element changes as a result of a variation of a physical property occurring throughout the volume of the medium of the holographic element, and the variation arises as a result of interaction between the medium and the analyte. Additionally, the reaction and the variation are reversible. On the other hand, the invention claimed in the '275 application is drawn to a sensor, method, and device for detecting an analyte comprising a *cis*-diol moiety. The claims of the '275 application include a

holographic element comprising a medium and a hologram disposed throughout the volume of the medium, wherein an optical characteristic of the element changes as a result of a variation of a physical property occurring throughout the volume of the medium. However, there is no mention in the claims of the '275 application of the variation being reversible, a key characteristic of the present invention which makes it patentably distinct over claims 1-19 of the '275 application.

Furthermore, there is no disclosure in claims 1-19 of the '275 application of a fluid being passed continuously over the holographic element, as required by claim 1 of the present invention. This is an additional feature making the subject invention patentably distinct over claims 1-19 of the '275 application.

Accordingly, reconsideration and withdrawal of the provisional rejection of claims 1-6 and 8-16 on the ground of nonstatutory obviousness-type double patenting over claims 1-19 of the '275 application is respectfully requested.

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10/565,094 (the '094 application). The applicants respectfully traverse this rejection in view of the above amendments.

By this amendment, claim 1 has been amended to incorporate the limitations of previous claim 8. Please note that this rejection was not applied to previous claim 8. The applicants submit that claim 1 is now patentably distinct from claim 14 of the '094 application because there is no mention in claim 14 of passing a fluid continuously over a holographic element. Accordingly, reconsideration and withdrawal of the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting over claim 14 of the '094 application is respectfully requested.

Claims 1-5 and 9 have been rejected under 35 U.S.C. §102(b) as being anticipated by Lowe *et al.* (U.S. Patent No. 5,989,923; the '923 patent). The applicants respectfully traverse this rejection because the Lowe *et al.* reference does not disclose the applicants' unique device and method as claimed herein.

It is a basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

By this amendment, claim 1 has been amended to incorporate the limitations of previous claim 8 (to which this rejection was not applied). Specifically, claim 1 now requires that the fluid is passed continuously over the holographic element. There is no disclosure in the '923 patent of a fluid passed continuously over a holographic element.

As noted above, it is well established that in order to anticipate, a single reference must disclose within the four corners of the document each and every element and limitation contained in the rejected claim. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). The '923 reference contains no mention of passing a fluid continuously over a holographic element. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b).

Claim 7 has been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. While the applicants gratefully acknowledge the Examiner's indication of allowable subject matter, reconsideration of this objection is earnestly solicited in view of the above amendments. Specifically, the applicants believe that claim 1, the rejected base claim from which claim 7 depends, is now allowable for the reasons set forth above. Accordingly, reconsideration and withdrawal of the objection to claim 7 is respectfully requested.

In view of the foregoing remarks and the amendments above, the applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

The applicant also invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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